RESPONSE UNDER 37 CFR 1.116
EXPEDITED EXAMINATION
EXAMINING GROUP 2655
Docket No.: 1572.1148

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Ki-keon YEOM et al.

Serial No. 10/676,144 Group Art Unit: 2655

Confirmation No. 6387

Filed: October 2, 2003 Examiner: Tai V. Nguyen

For: A DISC CENTERING DEVICE (AS AMENDED)

REQUEST FOR WITHDRAWAL OF FINALITY

AND NEW OFFICE ACTION

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

BOX AF

Sir:

This is in response to the Office Action mailed March 14, 2006, and having a period for response set to expire on June 14, 2006.

It is respectfully submitted that the outstanding Final Office Action, and the previous non-final Office Action, are based upon rejections rationales that hinge upon an unreasonable interpretation of features from a relied upon reference Baun, U.S. Patent No. 4,563,824. Withdrawal of the outstanding rejections and Office Action are respectfully requested.

It is respectfully submitted that the outstanding Office Action has taken an interpretation of a feature in Baun solely to force that feature to read on a claimed element "spacer", when the same "spacer" term is well known in the art, in addition to the application's description of the same.

The present application has set forth a clear example of how a "spacer" is to be interpreted, i.e., as devices placed between two disc to maintain a "spacing" between the two discs. See spacers 14 illustrated in FIGS. 2-4 of the present invention.

On page 4 of the Office Action issued March 14, 2006, the Examiner has stated that "[a]s for the spacer, in Baun Figure 2, shows at least 3 projections (not labeled) that extend from surface 220. These projections can each be read as a 'spacer.'"

However, it is unreasonable for the Examiner to take an interpretation of a term that is contrary to the well known term of the art, in addition to the fact that the Examiner does not know what the same relied upon projections are actually used for. Thus, the Office Action is clearly indicating that the relied upon projections do not have to meet the well known "spacer" usage.

As a general proposition, claim limitations are to be interpreted in light of its broadest reasonable interpretation. In re Prater, 162 USPQ 541, 550-51 (CCPA 1969), cited with approval, In re Morris, 44 USPQ2d 1023, 1028 (Fed. Cir. 1997).

However, the claims should be interpreted in light of their plain meaning as understood by one of ordinary skill in the art. In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989),citing, In re Prater.

In addition, the broadest reasonable interpretation must also conform to the broadest reasonable interpretation afforded by one of ordinary skill in the art ***when read in light of the specification***. In re Prater, 162 USPQ 541, 550-51, In re Morris, 44 USPQ2d at 1027, MPEP 2111.01 (7th Ed., rev. 1)(Feb. 2000).

Lastly, "[i]t is well established that agencies have a duty to provide reviewing courts with a sufficient explanation for their decisions so that those decisions may be judged against the relevant statutory standards, and that failure to provide such an explanation is grounds for striking down the action," in addition, ***"an agency is not free to refuse to follow circuit precedent."*** In re Lee 61 USPQ2d 1430, 1434 (CA FC 2002).

The Examiner's current interpretation of "spacer" is unreasonable, especially in view that the Examiner particularly notes that the reasons for such interpreted "spacer" projections is unknown. The Examiner cannot merely pick and choose features and redefine their purpose or applications.

Further, applicants' particular statements of what a "spacer" means **must** further be taken into consideration.

> Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002) "The district court erred in not according more weight to the inventor's definition. **It is well settled that a patentee may define a claim term either in the written description of the patent or, as in the present case, in the prosecution history.** Mycogen Plant Science v. Monsanto Co., 243 F.3d 1316, 1327, 58 USPQ2d 1030, 1039 (Fed. Cir. 2001). Frequently, a definition offered during prosecution is made in response to a rejection, and is entered in conjunction with

> a narrowing amendment. See, e.g., Southwall Techs., Inc. v. Cardinal IG Co., 54 F.3d 1570, 1576, 34 USPQ2d 1673, 1677 (Fed. Cir. 1995).
>
> Such a definition limits the scope of the claim, preventing the patentee from later recapturing what was previously surrendered. Although the inventor's definition does not have a narrowing effect, it is nonetheless relevant in indicating the meaning that the inventor ascribed to the term. See Vitronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1577 (Fed. Cir. 1996) ('[T]he record before the Patent and Trademark Office is often of critical significance in determining the meaning of the claims.'); E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co., 849 F.2d 1430, 1438, 7 USPQ2d 1129, 1135 (Fed. Cir. 1988) (prosecution history 'must be examined to ascertain the true meaning of what the inventor intended to convey in the claims') Honeywell Inc. v. Victor Co. of Japan Ltd., 63 USPQ2d 1904 (CA FC 2002).

Here, as the Office Action is taking such an incorrect interpretation of "spacer," it is further respectfully submitted that this interpretation is contrary to the disclosure of the present invention, contrary to the use of the same term by one of ordinary skill in the art, where the term "spacers" in known as being the devices placed between discs to separate discs, and contrary to applicants particular explanation and definition.

As the outstanding Final Office Action, and the previous Office Action, were based on a similar improper interpretation, applicants respectfully request a new non-final Office Action.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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Date: 5/5/06

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